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Paper No.

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON DC 20005-4051

MAILED

SEP 27 2010

OFFICE OF PETITIONS

In re Patent No. 7,709,009 : DECISION ON REQUEST
Grandi : FOR
Issue Date: May 4, 2010 : RECONSIDERATION OF
Application No. 10/565,126 : PATENT TERM ADJUSTMENT
Filed: September 18, 2006 : and
Atty Docket No. 002441.00187 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition pursuant to 37 C.F.R. § 1.705(d), filed on June 24, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred and four (704) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by six hundred and twenty-eight (628) days is **GRANTED** to the extent indicated herein.

The record supports a conclusion that this patent is not subject to a terminal disclaimer.

This patent issued on May 4, 2010, with a patent term adjustment of 635 days.

The Office has determined that the patent term adjustment for the above-identified patent is 628 days.

The 371 acceptance letter (M903), mailed on December 18, 2006, indicates that the fulfillment date (the date of completion of all 35 U.S.C. § 371 requirements) is September 18, 2006 and the priority date is July 31, 2003.

37 C.F.R. § 1.703(a)(1) states that the term of an original patent shall be adjusted by:

[t]he number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first...

This application fulfilled the requirements of 35 U.S.C. 371 in an international application on September 18, 2006, and a restriction requirement was mailed 14 months and 246 days later on July 21, 2008, resulting in 246 days of examination delay, pursuant to 37 C.F.R. § 1.703(a)(1).

37 C.F.R. § 1.703(a)(2) states that the term of an original patent shall be adjusted by:

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first...

A response to the aforementioned restriction requirement was received on September 22, 2008, and a non-final office action was mailed four months and 106 days later on May 8, 2009, resulting in 106 days of examination delay, pursuant to 37 C.F.R. § 1.703(a)(2).

It follows that the examination delay totals 352 (246 + 106) days. It is noted that the Office delay did not properly account for the aforementioned 106-day period of examination delay, and instead used a period of 9 days.

37 C.F.R. § 1.704(c)(10) states that the term of the original patent will be reduced due to the:

[s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months...

A notice of allowance was mailed on November 16, 2009. On February 16, 2010, Patentee submitted an after-final amendment. Eight days later, the Office mailed a "Response to Rule 312 Communication" on February 24, 2010. This warrants a reduction of nine days pursuant to 37 C.F.R. § 1.703(4)(c)(10)(i), as the day on which the supplemental response was received is included in the period of delay. It is noted that the Office did not properly account for this 9-day period of applicant delay, and instead used a period of two days.

Similarly, on February 18, 2010, Patentee submitted six sheets of replacement drawings. Seventy-five days later, this application matured into U.S. Patent no. 7,703,009 on May 4, 2010. This warrants a reduction of 76 days pursuant to 37 C.F.R. § 1.703(4)(c)(10)(i), as the day on which the supplemental response was received is included in the period of delay.

It follows that the applicant delay totals 85 (9 + 76) days.

This patent issued three years and 458 days after the 30-month anniversary of the priority date (January 31, 2006). However, the B-delay does not total 458 days, due to 97 days of overlap: regarding the aforementioned 106 days of examination delay which runs from January 22, 2009 to May 8, 2009, the period between January 31, 2009 and May 8, 2009 overlaps with the period of B-delay. This period totals 97 days.

It follows that the B-delay totals 361 (458 minus the 97 days of overlap) days.

As such, the patent term adjustment is increased by 628 (352 days of examination delay plus 361 "B-delay" minus 85 days of Applicant delay) days, not 704 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or Patentee an opportunity to be heard. Accordingly, Patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

This patent is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **six hundred and twenty-eight (628) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/

Paul Shanoski
Senior Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,709,009 B2

DATED : May 4, 2010

DRAFT

INVENTOR(S) : Grandi

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 635 days

Delete the phrase "by 635 days" and insert -- by 628 days--